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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|---------------------------|---------------------|------------------|
| 09/494,156 | 01/28/2000 | Christopher J. Fitzgerald | 99-642 | 3098 |
| 7590 | 08/12/2004 | | EXAMINER | |
| Bachman & Lapointe, P. C. 900 Chapel Street Suite 1201 New Haven, CT 06510-2802 | | | BROWN, TIMOTHY M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1648 | |

DATE MAILED: 08/12/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040805

Application Number: 09/494,156

Filing Date: January 28, 2000

Appellant(s): FITZGERALD ET AL.

George A. Coury
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 19, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's statement that claims 1-4 stand or fall together, as do claims 5-16 is correct and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). Claims 5-16 do not fall with claims 1-4 because claims 5-16 recite additional limitations.

(9) *ClaimsAppealed*

The copy of the appealed claims contained in the appendix to the brief is correct.

(10) *Prior Art of Record*

"Air Conditioners Are More Than Cool Air" PR Newswire July 23, 1998 (author unknown)

6282518

Farrel et al.

8-2001

(11) *Grounds of Rejection*

The rejection of claims 1 and 5 under 35 U.S.C. 103(a) as obvious over PR Newswire in view of Farrel is relevant to the appealed claims. These claims were rejected as follows:

Regarding **claim 1**, PR Newswire teaches a method of selecting an air conditioner including the steps of:

a merchant offering a customer a plurality of air conditioning products, each air conditioning product having a plurality of characteristics.

obtaining, by the merchant, intended use information from the customer for a desired air conditioner and an intended use location;

equating the intended use information with an intended use characteristic;

identifying a suitable air conditioner that matches the intended use product characteristic; and

identifying a suitable wherein a customer provides a merchant with an indication (pages 1 and 2).

PR Newswire does not teach a providing a database storing a plurality of air conditioning products and their corresponding characteristics. However, *Farrell et al.* teach an online method for configuring and purchasing an industrial product including the step of placing a number of product characteristics for a plurality of industrial products on a database (col. 7, lines 26-29). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify *PR Newswire* to include the teachings of *Farrell et al.* because storing a plurality of air conditioning products and their corresponding characteristics on a database would enable customers to shop for air conditioners online. Thus, modifying *PR Newswire* with the teachings of *Farrell et al.* would greatly enhance customer convenience by enabling the purchase of an air conditioner from any location with Internet access.

Regarding **claim 5**, *PR Newswire* teaches an interactive method for on-line selection of an air conditioning product, comprising the steps of:

a merchant offering a customer a plurality of air conditioning products, each air conditioning product having a plurality of characteristics.

obtaining, by the merchant, intended use information from the customer for a desired air conditioner and an intended use location;

equating the intended use information with an intended use characteristic;

identifying a suitable air conditioner that matches the intended use product characteristic; and

identifying a suitable wherein a customer provides a merchant with an indication (pages 1 and 2).

PR Newswire does not teach a providing a database storing a plurality of air conditioning products and their corresponding characteristics. However, *Farrell et al.* teach an online method for configuring and purchasing an industrial product including the step of placing a number of product characteristics for a plurality of industrial products on a database (col. 7, lines 26-29). At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify *PR Newswire* to include the teachings of *Farrell et al.* because storing a plurality of air conditioning products and their corresponding characteristics on a database would enable customers to shop for air conditioners online. Thus, modifying *PR Newswire* with the teachings of *Farrell et al.* would greatly enhance customer convenience by enabling the purchase of an air conditioner from any location with Internet access.

Further regarding claim 5, *PR Newswire* teaches product characteristics including a BTU rating for each air conditioner (page 2). *PR Newswire* also teaches interactively obtaining intended use location area from the customer, transforming the intended use location into an acceptable BTU capacity, obtaining further intended use

information, determining a correcting factor from the further intended use location information, and applying the correction factor to the acceptable BTU capacity so as to obtain a corrected BTU capacity thereby identifying a suitable air conditioner.

(11) Response to Argument

The Examiner offers the following comments in support the rejections set forth in the Final Office Action mailed July 17, 2003.

Issue 1

Appellant argues PR Newswire does not suggest *interactively shopping for an air conditioner over the Internet*.

First, the Examiner notes that PR Newswire teaches *interactively shopping for an air conditioner* in that it discloses a sales counselor recommending an air conditioner based on information provided by a customer (p. 2, lines 3-4). Thus, Appellant's argument is relevant only insofar as it relates to interacting *over the Internet*.

Second, claim 1 does not require the *Internet* in that the claim only recites "interactively obtaining intended use information from a consumer . . ." (lines 6-7). There is no mention of the Internet. Thus, PR Newswire does not need to teach, or suggest, *over the Internet* in order to render claim 1 obvious. Appellant's argument regarding *over the Internet* is moot.

Finally, Appellant's argument that PR Newswire does not suggest interacting *over the Internet* is unpersuasive. Appellant reasons that PR Newswire does not

suggest interacting over the *Internet* because it advises consumers to do research, or consult a trained sales counselor, before purchasing an air conditioner (brief p. 4, para. 2). However, this teaching would have actually motivated an artisan of ordinary skill to combine PR Newswire with Farell's online interactive function. This is because Farell simplifies the selection of industrial products (e.g. air conditioners) by interactively capturing a customer's product parameters over the Internet (see col. 7, lines 16-21). Therefore, by revealing that air conditioner shopping involves complex decisions that warrant the assistance of a sales counselor, PR Newswire suggests including Farrel's online interactive product selection method as a means for making it easier for consumers to select the right air conditioner.

Note that the knowledge generally available in the retail art would also have motivated the combination of PR Newswire and Farrel. This is because the only thing that PR Newswire lacks is *interacting over the Internet*. At the time of Appellant's invention, the advantages of having a merchant Web site were generally known. That is, it was generally known that a Web site provides 24-hour customer access to product information, more capacity to handle customer inquiries, and order fulfillment for any customer that has Internet access. Thus, the knowledge generally available in the retail art would have motivated the combination of PR Newswire with Farell's online customer interaction in order to (1) increase access to air conditioner product information, (2) increase customer service capacity, and (3) offer the merchant's products to the large volume of customers having Internet access.

Issue 2

Appellant argues the rejection of claim 5 is improper for the reasons discussed under claim 1. The Examiner therefore incorporates by reference the response under claim 1.

Appellant further argues PR Newswire does not teach or fairly suggest the steps of claim 5 including, (1) obtaining initial information from the consumer, (2) determining a BTU rating based on the information, (3) obtaining extra customer information, and (4) determining a correction factor based on the extra information (brief, p. 5, para. 3). However, the four steps argued by Appellant make up a routine method for selecting an air conditioner. PR Newswire teaches this method by disclosing a blueprint for air conditioner shopping. Regarding steps (1) and (2), PR Newswire teaches obtaining initial information and determining a BTU rating because it describes a salesman giving a customer an initial BTU recommendation based on the dimensions of the customer's room (p. 2, lines 3-4). PR Newswire also teaches steps (3) and (4). Regarding step (3), PR Newswire teaches obtaining extra customer information because it states a sales associate may consider (i.e. collect or inquire about) the heat level of a room (p. 2, line 10). This information is extra information because it is collected after the sales consultant makes an initial BTU recommendation based on room area (see Id.). Finally, PR Newswire teaches step (4) which is determining a correction factor based on the

Art Unit: 1648

extra information. PR Newswire teaches step (4) because it describes how a sales associate may revise a product recommendation for a room of specific size, based on the room's heat level information (i.e. extra information). This is the same as Appellant's correction factor which also revises an air conditioner selection based on "extra information." Based on the foregoing, PR Newswire teaches all four of the allegedly lacking steps.

For the above reasons, it is believed that the rejections should be maintained.